REMARKS

Claims 1-14 are pending in this application. It is believed that this Response is fully responsive to the final Office Action mailed June 3, 2003 (Paper No. 11).

The Applicant thanks Examiner Nhan Tran and Supervisory Patent Examiner Andrew Christensen for the Interview courteously granted Applicant's attorney September 2, 2003.

Claims 1-14 stand rejected under 35 USC 103(a) as being unpatentable over US Pat. 5,806,072 (**Kuba '072**) in view of US Pat. 5,576,759 (**Kawamura '759**). The Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness for a rejection of claims under 35 USC § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See the *Manual of Patent Examining Procedure* (MPEP) §§ 706.02(j) and 2143. If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

CLAIMS 1-14 ARE ALLOWABLE

The rejection of claims 1-14 is respectfully believed to be improper because Kuba '072 in view of Kawamura '759 fails to describe the following features set forth in base claims 1 and 7: "said image display means do not simultaneously display both images obtained from the normal pickup mode and the continuous image pickup mode."

Regarding those features of claims 1 and 7, the Examiner concedes that "Kuba does not teach that the image display means do not simultaneously display both images obtained from the normal pickup mode and the continuous image pickup mode" (Paper No. 11, pp. 4 and 8). The Examiner then attempts to remedy those deficiencies of Kuba '072 by erroneously suggesting that it would have been obvious to modify Kuba '072 with Kawamura '759 so that "the display means do not display both index pictures at the same time" (Paper No. 11, pp. 5 and 8). The Examiner's suggested combination of Kuba '072 and Kawamura '759 is respectfully believed to be unreasonable and improper because Kuba '072 teaches away from Kawamura '759, as explained below.

Kuba '072 describes improving efficiency of a retrieval of images by displaying different types of images together and indicates that the displaying of different types together improves efficiency. Kawamura '759, on the contrary, describes displaying the different types of images separately. In other words, Kuba '072 describes displaying images picked up individually together with images picked up continuously (FIG. 25B; col. 22, lines 5-12) to further its goal of improved

efficiency. Kawamura '759 displays images separately (FIG. 11B). Therefore, Kuba '072 teaches away from Kawamura's separate display of the different types of images.

It would not be reasonable to modify the display of Kuba '072 to cause it to be similar to the display of Kawamura '759, because Kuba '072 explains (col. 22, lines 5-12) that it has more efficiency than separate displays of images (such as that in Kawamura '759).

The combination of Kuba '072 and Kawamura '759 is unreasonable, and the rejection of claims 1-14 is improper, because Kuba '072 teaches away from Kawamura's separate display of the different types of images.

The col. 22 at lines 5-12 of Kuba '072, in conjunction with FIG. 25B, indicates that "efficiency of the retrieval can be improved" by displaying images picked up individually together with images picked up continuously.

When FIG. 25B (and col. 22 at lines 5-12) were discussed at the Interview on September 2, 2003, the US Patent and Trademark Office suggested that "Figure 25B is only one of the embodiments of Kuba." In response to that suggestion, the Applicant respectfully asserts that:

(1) Kuba '072 aims to solve (see FIG. 21B) the problem (see FIG. 21A) in displaying

different types of images (including individually picked-up images and continuously picked-up images) together, and is not based on the premise that different types of images are displayed separately; and

(2) Kuba '072 does not disclose any embodiment in which different types of images are displayed separately.

In view of the foregoing remarks, firstly the Examiner has not shown any reasonable suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings. Secondly, the Examiner has not shown a reasonable expectation of success. Thirdly, the Examiner has not shown that the references teach or suggest all the claim limitations of claims 1 and 7.

Accordingly, the Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness regarding claims 1 and 7, and therefore the rejection of claims 1-14 is improper and should be withdrawn.

CLAIMS 4, 5, 12, and 13 ARE ALLOWABLE

The rejection of claims 4, 5, 12, and 13 is respectfully believed to be improper because Kuba '072 in view of Kawamura '759 fails to describe the claimed copying means and moving means.

Firstly, the Examiner improperly suggests that Kuba '072 teaches the moving means of claims 4 and 12. Here, the Examiner relies on FIG. 32 and col. 24 at lines 22-37 (Paper No. 11, pp. 6 and 8). Those portions of Kuba '072 merely describe a general re-arranging of data.

Kuba's general re-arrangement of data does not teach or suggest "moving means for extracting ... an image selected by said second selecting means from the image group to which the image belongs, and storing the extracted image to said storing means of same directory as with an image picked up in said normal pickup mode" (claim 4). Also, Kuba's general re-arrangement of data does not teach or suggest "moving means for extracting the image selected by said second selecting means from the image group to which the image belongs, and storing the image in the same directory as for the image picked up in said normal pickup mode".

Secondly, the Examiner improperly suggests that Kuba '072 teaches the copying means of claims 5 and 13. Here the Examiner relies upon FIGS. 60 and 130, col. 31 at lines 14-29, and col. 47 at lines 27 and 44-46 (Paper No. 11, pp. 7 and 9). Those portions of Kuba '072 merely describe a general copying of data.

Kuba's general copying of data does not teach or suggest "copying means for forming a copy image of an image selected by said second selecting means and storing the copied image in said memory means of the same directory as for an image picked up in said normal image pickup mode"

(claim 5). Also, Kuba's general copying of data does not teach or suggest "copying means for forming a copy image of an image selected by said second selecting means and storing image in the same said directory as with the image picked up in said normal image pickup mode" (claim 13).

In view of the foregoing remarks, firstly the Examiner has not shown any reasonable suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the reference teachings. Secondly, the Examiner has not shown a reasonable expectation of success. Thirdly, the Examiner has not shown that the references teach or suggest all the claim limitations of claims 4, 5, 12, and 13.

Accordingly, the Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness regarding claims 4, 5, 12, and 13, and therefore the rejection of claims 4, 5, 12, and 13 is improper and should be withdrawn.

INTERVIEW SUMMARY

During the Interview on September 2, 2003, the following items were discussed: the last Office action (Paper No. 11); Kuba '072 and Kawamura '759; and claims 1, 4, 5, 7, 12, and 13.

In particular, the Applicant's attorney explained that the rejection of claims 1 and 7 is believed to be improper and should be withdrawn because the display of Kuba '072 (see FIG. 25B)

in fact teaches away from the display of Kawamura '759, and thus the Examiner's suggested modification of Kuba '072 (to adopt features of the display of Kawamura '759) is unreasonable.

Also, the Applicant's attorney explained that the rejection of claims 4, 5, 12, and 13 is believed to be improper because the cited art fails to teach the copying means and moving means as set forth by those claims. The US Patent and Trademark Office indicated that these remarks and arguments would be further considered when filed.

CONCLUSION

The Examiner has not established a *prima facie* case of obviousness. But it is the burden of the Examiner to do so by a preponderance of evidence. The US Patent and Trademark Office has the burden of proof, by a preponderance of evidence, to show that an applicant is not entitled to a patent because the claimed subject matter is anticipated by, or is obvious from, the art of record. A patent applicant is entitled to a patent "unless" the US Patent and Trademark Office establishes otherwise. See, e.g., *In re Dembiczak*, 175 F.3d 994, 1001 (Fed. Cir. 1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552 (Fed. Cir. 1992); *In re Fine,* 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Since the elements of a *prima facie* case, as spelled out by the Federal Circuit, have not been established here, the Applicant respectfully submits that he is entitled to a patent.

In view of the foregoing remarks, claims 1-14 are in condition for allowance, which action, at an early date, is respectfully requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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